

## REMARKS

Upon entry of this amendment, claims 1-9 will be canceled claims 10-14 will be represented in amended form, and new claims 15-21 will be added.

### 35 USC § 112

Claims 10-14 stand rejected under 35 USC § 112 as indefinite. Claim 10 has been amended to avoid the rejection. While it is clear that one of ordinary skill would be able to understand that the transfer member was being removed from proximate the receiving plate and the second plurality of pipette tips, Applicants have deleted the language relating to the receiving plate to avoid the rejection.

### Inventorship

At paragraph 3 of the Office Action, the Examiner discusses inventorship. Applicants are confused by this discussion and the reference to 37 C.F.R. § 1.56 inasmuch as there is no evidence, suggestion, discussion or indication in the record that any one or more of the identified inventors did not make the minimum inventive contribution to the disclosed and claimed inventions

Applicants are aware of their duty to disclose. Be that as it may, the listed inventors were at the time of the invention all employees of MEDAX, Inc., the actual owner of the present application. Under 35 U.S.C. § 103 (c ), if there was work of one inventory later advanced or undertaken by another inventor separate from the others at MEDAX, such work would not be regarded as prior art.

### 35 U.S.C. § 103 (a)

Claims 10-14 stand rejected under 35 U.S.C, § 103 as being obvious in view of Scaramella et al. (hereinafter Scaramella)

Scaramella as a reference has been reviewed at great length in other papers of record. There is no question that the device of Scaramella and the present device differ with the claimed device being a distinct improvement. The struggle with the present application is claim language and a way to define the invention with suitable breath without running into Scaramella. Indeed, the commercial embodiment of Scaramella was known to the inventors and is the device that the inventors inventively improved. The locking mechanism of Scaramella is and was unwieldy and difficult to use while adding cost to the product and waste to the trash can when done. The inventors improved and invented over Scaramella by developing a very elegant, albeit simple and unobvious solution. The inventors eliminated the lock between the transfer device and the supporting plate. At the same time, the projections from the transfer member were made longer to insert into the open end of the pipette tips. They were lengthened relative to the pipette tip to provide additional lateral or transverse support when the transfer member is in registry with the pipette tips. In turn, there is more transverse stability when the receiving card and the transfer member are being held between the thumb and a finger like the middle finger of a user.

There is no question that Scaramella shows a plate that would be comparable to the receiving plate of claim 10 and 16 and a transfer device that looks like a transfer member or plate of the present invention. To provide for removal, Scaramella teaches one to secure the transfer device to the receiving plate with “ [t]he latching mechanism ” Scaramella does NOT show, much less teach one to proceed without a mechanism to secure the transfer member to the receiving plate.

Scaramella also teaches one to size the bosses to be short and stubby relative to the length of the pipette tips (see Scaramella et al., FIG. 8). This feature of Scaramella et al., in conjunction with use of the holder card and the latching mechanism, is purported to result in a stable

engagement of the pipette tips with respect to the transfer plate. Short and stubby bosses, however, permit the pipette tips to wobble with respect to the transfer plate when the latching mechanism is not attached. The user, therefore, is required to attach the latching mechanism to the system prior to affecting a stable transfer of the pipette tips. The latching mechanism is thus, essential to providing a useful product when the bosses are of a short and stubby nature.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Because certain of the claim limitations of Applicant's invention are not taught or suggested by Scaramella, Applicants assert that the claims are not obvious.

Turning to claim 10, we can see that the receiving plates as now defined are "unconnected and unconnectable to any other structure" thus clearly defining away from Scaramella. Claim 10 has a transfer member or plate " configured to NOT BE CONNECTABLE TO ANY RECEIVING PLATE ..." (emphasis added). Thus, we have the plate and transfer device unconnectable so they cannot definitionally have the latch that is essential to Scaramella.

In claim 10, we also see that the "projections" extend "from the lower surface a preselected distance to effect stable engagement." This structure feature is not apparent in, suggested by, or taught by Scaramella.

In summary then, the method of claim 10 as herein amended clearly defines a method not found in Scaramella. It is not obvious in view of Scaramella because the method of claim 10 operates contrary or opposite to the teachings of Scaramella. Where Scaramella teaches short bosses and latching, the method of claim 10 proceeds with a device having no latching or

latching excluded along with longer bosses. Claim 10 specifically by its language excludes the structures of Scaramella and those that would be suggested by Scaramella. That is, there is nothing that could allow the receiving element and the transfer member to become latched or locked or tied together mechanically.

Claim 10 as now amended and claims 11-14 dependent there from are thus allowable.

#### New Claim 15

New claim 15 is presented and is dependent on from claim 10 which is now allowable.

In turn, claim 15 is allowable for the same reasons as is claim 10

#### Represented Structure Claims

Claims 2-4, 6,7 and 9 were in the case but canceled. They are in substance re-presented and amended in a new form to define over the art.

In paragraph 7 of the Office Action, the Examiner here responds to arguments pointing out that the claims 10-14 involve open ended language such as “comprising” with a further explanation that the claim could be construed to cover product configured comparable to Scaramella.

Applicants vehemently disagree. Claims must be read in light of the specification. No open-ended reading of any of the claims earlier or now presented would allow one to reach back and cover a device that has a physical connection between the receiving plate and the transfer member. The teaching, structure and description are how to avoid such structure. No doctrine of liberal claim construction allows the reader to incorporate structure that is contrary to the teachings of the specification. That is, broad claim reading cannot go beyond the specification to the point that the claim is being construed contrary to the teachings and structure. Claim

construction doctrines DO NOT permit claim construction to proceed contrary to the teaching of the specification.

Be that as it may, and in an effort to avoid further discussion, Applicants have here in claim 16 defined a receiving card that is “unconnected” with “only” a matrix of apertures for the pipette tips. The transfer member has “no structure” for attaching to the receiving card. Thus, we have claims that define away from Scaramella. The spacing distance and the length of the projections is also defined. Thus, claim 16 and claims 17-20 dependent therefrom clearly define over the art. They are thus allowable over Scaramella.

Turning to claim 21, we have defined structure that excludes others by reciting that the claim is “consisting essentially of”. Thus there may be other minor additions that could be added but not a latching mechanism. for latching the two together. Further the “spacing distance” is now carefully defined. Claim 21 thus defines over Scaramella and should be allowable.

### **CONCLUSION**

Applicants have demonstrated the importance of the differences and the unobvious nature of the invention as now defined by the claims when compared with Scaramella et al. Applicants have proceeded in a direction not taught or suggested by Scaramella et al. and in a manner that is totally inconsistent with Scaramella et al. Scaramella et al. teaches the need for a mechanical connection between the transfer plate and holder card prior to affecting transfer of the pipette tips. Applicants teach elimination of the mechanical connection, thus greatly simplifying the transfer process and reducing cost and waste associated with the latching mechanism.

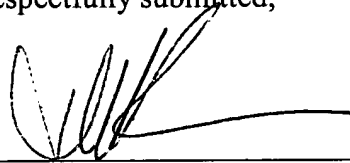
The rejection of claims 10-14 is deemed avoided and the rejection of claims 2-4, 6, 7 and 8 as they may be applicable to new claims 16-21 are also avoided. In turn, all claims should be allowable.

Early action and allowance is respectfully requested for all pending claims.

Please charge any fees not accompanying this communication that may be required to deposit account 08-2665.

If there are questions, the Examiner can reach applicants' counsel at (801) 521-5800 or by e-mail at [rossat@HRO.com](mailto:rossat@HRO.com). Please note that applicants' counsel is now at a new address.

Respectfully submitted,



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Thomas J. Rossa  
Registration No. 26,799  
Customer Number 34013  
Attorney for Applicants  
HOLME ROBERTS & OWEN LLP  
299 South Main, Suite 1800  
Salt Lake City, Utah 84111-5233  
Telephone: (801) 521-5800

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